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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,057	08/01/2001	Valtteri Niemi	324-010477-US (PAR)	4430

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PERMAN & GREEN  
425 POST ROAD  
FAIRFIELD, CT 06824

EXAMINER
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DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/920,057	Applicant(s) NIEMI ET AL.	
	Examiner Zachary A. Davis	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 12, 17-24, 27, 28, 33-40, 43 and 44 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 13-16, 25, 26, 29-32, 41, 42 and 45-48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 November 2006 has been entered.

2. By the above submission, Claims 1, 3, 13-15, 17, 19, 31, and 33-48 have been amended. No claims have been added or canceled. Claims 1-48 are currently pending in the present application.

### ***Response to Amendment***

3. Copies of the translation of the foreign priority document, Finnish Application 20001734, were received on 20 October 2005 and 29 November 2005. With the filing of the request for continued examination under 37 CFR 1.114, received 09 January 2006, the copies of the translation are now considered to be seasonably presented, and are made of record in the present application.

***Response to Arguments***

4. Applicant's arguments filed 29 November 2005 have been fully considered but they are not persuasive.

Specifically, the translation of the foreign priority document has been made of record, and thereby overcomes the filing date of the Fauconnier et al reference (US Patent 6768903). However, in reference to the rejections of Claims 1-8, 11, 12, 17-24, 27, 28, 33-40, 43, and 44, the cited portions of Fauconnier were in the "Background of the Invention" section. The background of Fauconnier refers back to several technical specifications published by the 3<sup>rd</sup> Generation Partnership Project, specifically: 3G TS 25.301, version 3.4.0, published March 2000; 3G TS 25.401, version 3.1.0, published January 2000; 3G TS 25.331, version 3.1.0, published October 1999; 3G TS 25.332, version 3.2.0, published March 2000; 3G TS 25.321, version 3.3.0, published March 2000; 3G TS 25.212, version 3.0.0, published October 1999; and 3G TS 25.832, version 3.0.0, published October 1999. Because the publication dates are made of record in the Fauconnier reference, the cited portions are variously accorded prior art dates (as publications under 35 U.S.C. 102(a)) based on the publications referred to. Therefore, the prior art dates of the portions of the Fauconnier reference cited are earlier than the foreign priority date (01 August 2000), and therefore Claims 1-8, 11, 12, 17-24, 27, 28, 33-40, 43, and 44 remain rejected.

However, in reference to the rejections of Claims 9, 10, 13-16, 25, 26, 29-32, 41, 42, and 45-48, the cited portions of Fauconnier were in the "Description of Preferred

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Embodiments" and do not refer back to the abovementioned specifications. Therefore, the filing of the translation of the foreign priority document overcomes these rejections, and the rejection of Claims 9, 10, 13-16, 25, 26, 29-32, 41, 42, and 45-48 under 35 U.S.C. 102(e) as anticipated by Fauconnier is hereby withdrawn.

***Claim Rejections - 35 USC § 112***

5. The rejection of Claims 1-48 under 35 U.S.C. 112, second paragraph, as indefinite is withdrawn in light of the amendments to the claims.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-8, 11, 12, 17-24, 27, 28, 33-40, 43, and 44 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Fauconnier, US Patent 6768903, noting that the portions relied upon further cite back to technical specifications published by the 3<sup>rd</sup>

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Generation Partnership Project, specifically: 3G TS 25.301, version 3.4.0, published March 2000; 3G TS 25.401, version 3.1.0, published January 2000; 3G TS 25.331, version 3.1.0, published October 1999; 3G TS 25.332, version 3.2.0, published March 2000; 3G TS 25.321, version 3.3.0, published March 2000; 3G TS 25.212, version 3.0.0, published October 1999; and 3G TS 25.832, version 3.0.0, published October 1999.

In reference to Claim 1, Fauconnier discloses a method for transmitting data between a network using packet-switched TDMA and a user mobile equipment, that includes encrypting data to be transmitted, transmitting the encrypted data, and deciphering the transmitted data (see column 3, line 63-column 4, line 2), and in which the encryption algorithm of a network using wideband CDMA is used with parameters adapted to parameters of the packet-switched TDMA network (see column 4, lines 61-67, where it is possible to use the same ciphering procedures in a UTRAN and a GERAN).

In reference to Claim 2, Fauconnier further discloses that a format of the parameters includes a number and length of each parameter (column 4, lines 5-16).

In reference to Claim 3, Fauconnier further discloses that the implementation of the encryption algorithm is the same in both the packet-switched TDMA network and the wideband CDMA network (column 4, lines 61-67).

In reference to Claims 4 and 5, Fauconnier further discloses a counter parameter (column 4, lines 8-9).

In reference to Claim 6, Fauconnier further discloses the use of a bearer parameter (column 4, lines 10-11).

In reference to Claims 7, 8, 11, and 12, Fauconnier further discloses that the encryption algorithm can be executed in either the MAC layer or the RLC layer (column 5, lines 37-41), and that the counter parameter includes a frame number (column 5, lines 49-54).

Claims 17-24, 27, and 28 are directed to an apparatus, specifically user equipment, that corresponds substantially to the method of Claims 1-8, 11, and 12, and are rejected by a similar rationale.

Claims 33-40, 43, and 44 are directed to an apparatus, specifically a radio access network, that corresponds substantially to the method of Claims 1-8, 11, and 12, and are rejected by a similar rationale.

### ***Allowable Subject Matter***

8. Claims 9, 10, 13-16, 25, 26, 29-32, 41, 42, and 45-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The prosecution history as a whole makes clear the reasons for indicating allowable subject matter (see especially Applicant's arguments filed 29 November 2005

and the response to those arguments hereinabove), and therefore reasons for indicating allowable subject matter are not necessary. See 37 CFR 1.104(e).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ZAD  
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EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER